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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,508	12/05/2003	Lavinia C. Popescu	02.36US	9085
23487	7590	11/30/2006		
THE ESTEE LAUDER COS, INC 155 PINELAWN ROAD STE 345 S MELVILLE, NY 11747			EXAMINER KOSSON, ROSANNE	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,508

Applicant(s)

POPESCU ET AL.

Examiner

Rosanne Kosson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed on November 9, 2006 has been received and entered. Claims 1, 3, 5-7, 10, 12 and 14-16 have been amended. Claims 19-20 have been canceled. No claims have been added. Accordingly, claims 1-18 are examined on the merits herewith.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, second paragraph

In view of Applicants' amendments to the claims, this rejection is withdrawn.

Claim Rejections - 35 USC § 102

Claims 1-3, 6-12 and 15-18 are again rejected under 35 U.S.C. 102(b) as being anticipated by Kanebo Ltd. (JP 02-204407, see English full-text translation and English abstract) as evidenced by Ajinomoto Co. Inc. (JP 03-213574, see English translation). This rejection was discussed in the previous Office action.

Applicants have argued the rejection, their main argument being that Kanebo does not disclose applying the transglutaminase-containing composition to hair that has been curled. Applicants also assert that Kanebo's teaching that the transglutaminase-containing composition makes the hair more elastic, more flexible and springier does not mean that Kanebo teaches applying this composition to curled hair, because all hair is springy, flexible and elastic, whether or not it has been curled. Applicants assert that the springiness of hair results from the recovery of its original conformation after being untwisted from its coiled coil shape, the shape of keratin fibers. Further, Applicants assert that the effect of applying the product of Kanebo to hair is

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speculation. Applicants note additionally that cold perms can make hair curly or straight, and, therefore, it is only possible or probable that Kanebo teaches applying a transglutaminase-containing composition to curled hair.

In reply, as previously discussed, Kanebo discloses a hair cosmetic composition comprising transglutaminase that is designed for and applied to hair that is frequently permed, subjected to a hair dryer and/or washed (see p. 2, 1st and 4th paragraphs of the full-text translation). Thus, Kanebo clearly teaches applying this composition to hair that has been curled. The chemicals used to perm hair in the sense of curling it may also be formulated as a relaxer. Examiner does not dispute this point. But, in view of Applicants' argument, Kanebo teaches applying a transglutaminase-containing composition to hair that has been curled or relaxed, the cross-linking enzyme transglutaminase, therefore, reinforcing either type of artificial shape, i.e., hair that is artificially curly or artificially straight. On p. 11 of their Appeal Brief of August 10, 2006, Applicants note that Kanebo is a Japanese company, and, therefore, its products are intended for consumers with straight hair. Examiner does not dispute this point, as Kanebo has developed products for treating hair that has been damaged by excessive perming. Japanese people who have their hair permed are far more likely to have their hair curled than straightened.

Regarding the new limitations reciting the amounts of transglutaminase in Applicants' compositions, all of these ranges are within the effective range disclosed by Kanebo, 0.01% by weight or 0.1% by weight (see Examples 1, 3 and 4, pp. 6-7 of the full-text translation), as previously discussed. Thus, the claims as amended do not overcome the rejection at hand.

Regarding making the hair springier or more elastic, Applicants have recited a pertinent section of the previous Office action. The claims are very broad and recite simply a method of enhancing or retaining curl. The portion of the claims that recites that transglutaminase can

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perm hair (impart curl to hair), which Kanebo does not teach, has been canceled. As previously discussed, Kanebo discloses that transglutaminase cross-links hair and makes it more elastic. Thus, the paragraph of the previous Office action that Applicants cite still applies. The specific disclosure of curled hair, permed hair, that Applicants refer to is as noted above, p. 2, lines 2-4. As for Applicants' assertion that elasticity refers to the ability of keratin fibers to recover their coiled coil shape when pulled out of shape, a property that Applicants call elasticity on the micro level, this assertion is Applicants' idea, and it is not part of Kanebo. But, this assertion is compatible with the teachings of Kanebo and does not contradict the teachings of Kanebo. Kanebo is concerned with the cosmetic treatment of damaged permed hair, as well as hair damaged by other factors, and Kanebo has developed conditioning products for these types of hair. Applicants note that the teachings of Kanebo are on the macro level, where Kanebo plainly discloses Applicants' method, a one-step method of applying a transglutaminase-containing composition to permed hair for the intended use of making the hair softer and more elastic, which enhances and retains curl. As previously discussed, because Kanebo's method step is the same as Applicants', it has the same function and the same effect.

Applicants use the word "speculation," but nothing the instant rejection is speculation.

Applicants also cite case law, *Perricone v. Medicis Pharm. Corp.*, but this case law is not analogous to Applicants' situation. In the cited case, Applicants note that the Court noted that a method of treating sunburn was not anticipated by an earlier reference that taught that the composition used in the sunburn-treatment could be applied to skin in general. The earlier reference taught that its composition was a moisturizer and did not mention sunburn. As a result, one of the patents in suit, the '693 patent, was considered to be in the class of a new method of using an old product. But, Applicants' case is not analogous, because the rejection is not that the claimed method is rejected by the composition of Kanebo. As previously discussed,

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the claims do not recite any elements that are not taught by Kanebo, particularly as the claim portion to a method of imparting curl to hair has been canceled.

In view of the foregoing, the rejection of record is maintained.

Claim Rejections - 35 USC § 103

Claims 1-4, 6-13 and 15-18 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Kanebo Ltd. (JP 02-204407, see English full-text translation and English abstract) in view of Ajinomoto Co. Inc. (JP 03-213574, see English translation); Dane, Hair Chemistry 1, The Trichological Society, www.hairscientists.org/hair-chemistry.htm, ©2000, printed from the Internet on July 26, 2004, and the record for transglutaminase from BRENDA, http://www.brenda.uni-koeln.de/php/result_flat.php4?ecno=2.3.2.13, printed July 26, 2004.

Applicants have argued the rejection, asserting as above, that Kanebo and Ajinomoto do not disclose applying a transglutaminase-containing composition to a curled human keratinous material. Applicants also assert that Dane does not disclose the use of transglutaminase, nor does BRENDA.

In reply, Kanebo's disclosure of applying a transglutaminase-containing composition to permed human hair is discussed above.

As for Dane, it is clear in the previous Office action that Dane was cited for its teaching that cross-linking imparts curl to hair and keeps it curly. Because it was known at the time of Applicants' invention that transglutaminase was a cross-linking agent, one of ordinary skill in the art at the time that the invention was made would have expected a transglutaminase treatment to retain and enhance curls in hair. It is the added cross-links in the hair, added covalent bonds, that restrict the keratin protein to a particular shape. It is not critical which amino acids are bound.

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As for BRENDA, it is clear in the previous Office action that BRENDA was cited for its teachings related to the optimum pH for transglutaminase, not for teaching a particular method.

In view of the foregoing, the rejection of record is maintained.

Claims 5 and 14 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Kanebo Ltd. (JP 02-204407, see English full-text translation and English abstract) in view of Ajinomoto Co. Inc. (JP 03-213574, see English translation); Dane, Hair Chemistry 1, The Trichological Society, www.hairscientists.org/hair-chemistry.htm, ©2000, printed from the Internet on July 26, 2004, and the record for transglutaminase from BRENDA, http://www.brenda.uni-koeln.de/php/result_flat.php4?ecno=2.3.2.13, printed July 26, 2004, and further in view of product literature for eyelash perms from E-Z Permanent Makeup (<http://www.eyelashperm.com>, which has an embedded link for ordering and product information at <http://www.ezpermanentmakeup.com>), printed from the Internet on July 26, 2004. The teachings of Kanebo, Ajinomoto, Dane and BRENDA are discussed above.

Applicants assert that E-Z Permanent Makeup discloses only that a permanent wave may be applied to eyelashes using only conventional perming agents. This reference does not disclose using transglutaminase.

In reply, it is clear in the previous Office action that E-Z Permanent Makeup was cited for its teaching that hair keratin can be permed, whether it is eyelash hair or head hair. It is clear that this reference was not cited for a disclosure of a method of using transglutaminase. This is an obviousness rejection, not an anticipation rejection, and the rejection is the combination of the teachings of all the cited references. Applicants' method, as recited in the broader amended claims, is disclosed by Kanebo. A person who had permed head hair or permed eyelashes would have wanted to retain or enhance either type of perm (after going to the trouble and

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expense of the perm), and it would have been obvious to this person or to a salon stylist who does these perms to treat such permed hair or eyelashes according to the method of Kanebo.

In view of the foregoing, the rejection of record is maintained.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-6:00, alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

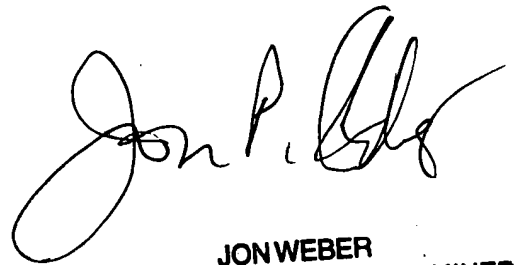
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rosanne Kosson
Examiner, Art Unit 1652

rk/2006-11-21

RK

A handwritten signature in black ink, appearing to read "Jon Weber", with a large, stylized loop at the end.

JON WEBER
SUPERVISORY PATENT EXAMINER